



UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/809,723	05/21/97	OHKI	H 18-971-0-PCT

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HM11/0605

EXAMINER
MARSHALL, S

ART UNIT	PAPER NUMBER
1654	9

DATE MAILED: 06/05/98

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No. 08/809723	Applicant(s) OHK1 et al
Examiner Marshall	Group Art Unit 1654

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☐ Responsive to communication(s) filed on _____.
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-16 and 19 is/are pending in the application.
- ☐ Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-16 and 19 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____.
 - ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of References Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

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Claims 1-16 and 19 are pending in the case, and claims 17-18 have been cancel.

The rejection of claims 1-16 and 19 under 103(a) as being unpatentable over Toshiro et al (EPA0462531) or Toshiro et al (Us Patent 5, 376634) has been maintained as set forth in the office action mailed August 28, 1997 on pages 2-3 . Additionally, the rejection of claims 1-16 and 19 under the judicially created doctrine of obviousness-typed double patenting has been maintained.

Applicant's arguments filed March 2, 1998 have been fully considered but they are not persuasive.

Applicants agree with the examiner that the compounds of instant invention falls within the scope of the invention as taught by Toshiro et al. However, applicants' argue that the examiner provides no reason as to why one of skill in the art would be motivated from the teaching of the reference, to pick the specific acyl group of the instant invention.

Although the patent of Toshiro et al teaches R1 is acyl, Toshiro et al also define acyl groups as being lower alkanoyl, e.g. formyl , acetyl , propionyl, butyl... which may be substituted....(see Toshiro et al, col. 6, lines 30-68), , of which the preferred acyl is lower alkanoyl, including heterocyclic lower alkanoyl (see col.8, lines 14-68). These compounds read essentially on the compounds of applicants(see spec. 2-20) Therefore the compounds of the instant invention largely overlap the compounds of the reference, and one of ordinary skill in the art at the time that the invention was made would have been motivated to preferentially select the desired acyl group to obtain compounds of the instant invention that possess anitmicrobial

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activity, especially anti fungal activity. Applicants' situation is not an In re Baird situation. In in re Baird, one would have to pick and choose from various radicals to come up with the claimed invention. In this invention, there is a large overlap in the compounds.

The Declaration submitted by applicants has been carefully considered, however; the small number of peptides tested is not commensurate in scope with the protection sought. Therefore the rejections are maintained. However, the specific compounds tested and showed unexpected results are allowable if presented.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

1. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sandra Marshall whose telephone number is (703) 308-1030.

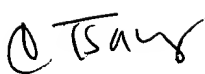
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June 4, 1998


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GROUP 1000